



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 12

MADSON & METCALF
GATEWAY TOWER WEST
SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY UT 84101

COPY MAILED

JAN 13 2005

OFFICE OF PETITIONS

In re Patent No. 6,588,126 :
Issue Date: July 8, 2003 : **ON PETITION**
Application No. 09/834,147 :
Filed: April 12, 2001 :
Attorney Docket No. 2001.2.6 :
:

This is in response to the communication entitled "LATE SUBMISSION OF PRIORITY DOCUMENTS" filed August 31, 2004, which is being treated as a petition under 37 CFR 1.55(a) for entry of late submission of priority documents for Australia Patent Application Nos. PQ6887, filed April 13, 2000 and PQ7644, filed May 19, 2000, after the patent has been granted.

The petition is dismissed.

Under the rule (37 CFR 1.55 (a)(2)), an applicant who wishes to secure the right of priority must comply with certain formal requirements within a time specific. If these requirements are not complied with the right of priority is lost and cannot thereafter be asserted.

Inspection of the instant record reveals that although a claim for foreign priority under 35 U.S.C. § 119 was lodged in a declaration filed with the instant application on April 12, 2001, the certified copy of the priority document was not filed until subsequent to the issuance of the above-captioned patent. Specifically, the requirements of the rule are (a) that the applicant must file a claim for the right and (b) he or she must also file a certified copy of the original foreign application, and (c) these papers must be filed within a certain time limit. The maximum time limit specified in the rule is that the claim for priority and the priority papers must both be filed before

the patent is granted. See 37 CFR 1.55 (a)(2). If the required papers are not filed within the time limit set the right of priority is lost. Since the certified copy of the priority document was not, as required by the rule, filed in the above-identified application until after the patent was granted, the petition must be dismissed.

However, a reissue was granted in Brenner v. State of Israel, 862 O.G. 661; 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was an applicant's failure to file the certified copy of the original foreign application under 35 U.S.C. § 119 before the patent was granted. Under the circumstances of this case, petitioner may wish to seek relief from his predicament by way of reissue under 35 U.S.C. § 251. Id. See also 65 F.R. 57024, supra; MPEP §§ 201.16, 1402.

Any questions concerning this decision on petition should be directed to the undersigned at (571)272-3208.

The patent file is being forwarded to Files Repository.



Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy